



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/027,714

12/21/2001

David M. Austin

AUZ-002 P

6090

7590
Wesley L. Austin, Esq.
1244 E. 1650 S.
Bountiful, UT 84010

07/29/2008

EXAMINER

BROWN, CHRISTOPHER J

ART UNIT

PAPER NUMBER

2134

MAIL DATE

DELIVERY MODE

07/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. AUSTIN and WESLEY L. AUSTIN

Appeal 2007-0577
Application 10/027,714¹
Technology Center 2100

Decided: July 28, 2008

Before JAMES D. THOMAS, JEAN R. HOMERE, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 21. Claims 22 through 34 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed on Dec. 21, 2001. The real party in interest is Trapware Corp.

Appellants invented a method and system for scanning a computer to detect therein the presence of observer programs that monitor and record a user's activities on the computer. (Spec. 4.) As depicted in Figure 2, an observer program (34) gathers data from various activities (36, 38, 42) occurring on a computer (20) and stores the collected data in a log file (44). (Spec. 12.) As shown in Figure 3, an observer detector (50) is installed on the computer to detect the presence of such observer programs by comparing before and after image contents of the computer memory (24) at a predetermined time. (Spec. 13-15.)

Independent claim 1 further illustrates the invention. It reads as follows:

1. A computer program embodied in a computer-readable medium for scanning a computer for observer programs, the computer program comprising:

observer data comprising a plurality of observer program characteristics descriptive of a plurality of observer programs where the observer programs are programmed to observe activities on a computer system and to create log data;

reading instructions that read memory of the computer to obtain memory data;

comparing instructions that compare the plurality of observer program characteristics with memory data characteristics to determine whether an observer program is present on the computer;

generating instructions that generate results from the comparing, wherein the results generated indicate whether the observer program is present on the computer; and

outputting instructions that provide the results through a graphical user interface.

The Examiner relies on the following prior art:

Drake	US 6,006,328 B1	Dec. 21, 1999
Togawa	US 6,240,530 B1	May 29, 2001

The Examiner rejects the claims on appeal as follows:

Claims 1 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Togawa and Drake.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Togawa

1. Togawa discloses a method and system for detecting and exterminating viruses on a computer. Particularly, Togawa discloses a virus extermination program installed on the computer memory to detect, identify and destroy certain types of viruses on the computer. (Col. 4, ll. 1-22.)

2. After detecting characteristics in memory indicating the presence of a virus, the extermination program identifies the name and type of the virus to subsequently destroy it. (Col. 5, ll. 9-18; col. 8, ll. 22-30.)

Drake

3. Drake discloses a method and system that uses an anti-spy computer code to detect rogue software programs that eavesdrop, attack or steal ID-data on the computer. The anti-spy code continuously scans the computer memory by comparing its memory image data with known characteristics data to detect hot patching. (Col. 3, ll. 38-44; col. 6, ll. 10-20.)

PRINCIPLES OF LAW

OBVIOUSNESS

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) wherein evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007)). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the

art. *KSR*, 127 S. Ct. at 1740-41. *See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2007).

ANALYSIS

Independent claim 1 recites in relevant part detecting the presence of observer programs that observe activities on a computer system to create a log of data by comparing observer program characteristics with memory data characteristics. (Claims Appendix.) Appellants argue that the combination of Togawa and Drake does not teach these limitations. (App. Br. 6-9.) Particularly, Appellants argue that the combination of Togawa and Drake teaches detecting the presence of virus programs on the computer, and not observer programs. (*Id.*)

In response, the Examiner avers that Togawa's disclosure of detecting and identifying the characteristics of virus programs on a computer, taken in combination with Drake's disclosure of using anti-spy techniques to detect unauthorized spying software programs on the computer, teaches the cited limitations. (Ans. 8-11.)

Therefore, the pivotal issue before us is whether one of ordinary skill in the art would have found that Togawa's virus detection mechanism combined with Drake's use of anti-spy techniques to detect the presence of a rogue software on a computer teaches the limitations in question, as recited in independent claim 1. We answer this inquiry in the affirmative.

As set forth in the Findings of Fact section, Togawa teaches running a virus check on a computer to detect the presence of virus characteristics thereon, and to identify the types of viruses corresponding thereto. (FF 1-2.) Further, Drake teaches scanning a computer memory by running therein an anti-spy software, which compares before memory scan images with after memory scan images to detect the presence of a rogue software thereon. (FF. 3.) One of ordinary skill in the art would readily recognize that the detection of viruses in a computer memory, as taught by Togawa, routinely involves comparing known virus characteristics with data in the computer memory to identify similar data patterns. Further, the ordinarily skilled artisan would recognize that Drake's use of anti-spy software explicitly involves a comparison between known characteristics data with memory data to identify similar data patterns indicating the presence of rogue software in the computer. The ordinarily skilled artisan would therefore conclude that the proffered combination would *predictably result* in running anti-spyware program on a computer to scan the memory for certain spy characteristics in order to detect the presence of rogue software programs thereon.

Additionally, we note that Appellants' arguments regarding the informational content of the compared characteristics data are not persuasive. Nowhere in the cited claim is there an indication that the nature of the compared data and the content thereof are being used to functionally achieve something other than merely detecting the presence of a

corresponding software. We are satisfied that both the claimed invention and the Togawa-Drake combination are directed to comparing known characteristics data with data in the computer memory for the same purpose of detecting the presence of a corresponding software. Thus, whether the characteristics data indicate to an observer program or a virus/rogue program, the nature of the data being compared here is of little importance. In either case, the computer memory is scanned by comparing characteristics data to detect the presence of a corresponding software. Consequently, the informational content of program characteristics is nonfunctional descriptive material, which is entitled to no patentable weight. *See Manual of Patent Examining Procedure* (MPEP) § 2106.01 (8th ed., Rev. 5, Aug. 2006).

When “non-functional descriptive material” is recorded or stored in a memory or other medium (i.e., substrate), it is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.”). *See also Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1003; affirmed without written opinion Jun. 12, 2006). The Examiner need not give patentable weight to descriptive material absent a new and

unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; affirmed without written opinion Aug. 17, 2006).

It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Togawa and Drake renders independent claim 1 unpatentable.

Appellants do not provide separate arguments with respect to the rejection of dependent claims 2 through 21. Consequently, these claims fall together with independent claims 2 through 21. 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in concluding that claims 1 through 21 are unpatentable over the combination of Togawa and Drake under 35 U.S.C. § 103.

DECISION

We affirm the Examiner's decision rejecting claims 1 through 21.

Appeal 2008-0577
Application 10/027,714

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

Wesley L. Austin, Esq.
1244 E. 1650 S.
Bountiful UT 84010